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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/832,440

Applicant(s)

MORSA, STEVE

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-180 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-180 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 7/10/2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed.
2. The reference listed on the IDS under "Steve Morsa. Additional Printed-Material Benefit Information Sources 1985-1999. Amazon.com search results. 2 pages. Thousand Oaks CA." contained only a listing of references. This listing has been placed in the application file, but the information referred to therein has not been considered.

### ***Specification***

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.
4. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

5. The language should be clear and concise and should not repeat information given in the title.

It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 75, 76, 159, and 160 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
9. Neither the method/system used to aggregate entities nor the method/system used to identify the additional benefits / improved conditions are described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention.
10. Claims 11-17, 54-55, and 138-139 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
11. Claims 11-16 recite the limitation "said plurality of benefits" in the system of claim 1. There is insufficient antecedent basis for this limitation in the claim.

12. Claims 54 and 138 recite the limitation "said application forms" in the system of claim 1 and the method of claim 87 respectively. There is insufficient antecedent basis for this limitation in the claim.
13. Claims 17, 55, and 139 are rejected, as they are dependent on rejected claims.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1, 16-21, 25-27, 46-50, 54, 55, 58-62, 64-74, 77-87, 101-106, 110-112, 131-134, 138, 139, 142-146, 148-158, 161-164, 166-169, 171-180 are rejected under 35 U.S.C. 102(b) as being anticipated by College Board (www.collegeboard.com, Screen Print, 1/25/1999).
16. As per independent Claims 1 and 87, College Board discloses a system / method for permitting an entity to more effectively make use of a variety of available benefits from a plurality of goods, services, information, and value benefit providers, wherein said benefits are offered specifically to those entities qualified/eligible to receive said benefits, said system comprising: means for storing in a memory in the system entity information, benefit-provider information, and benefit correlation information; means for inputting into said system a set of entity demographic, geographic, psychographic, and preference data for said entity; means for comparing said entity data set to determine those benefit-providers, if any, which have benefits said entity is qualified to utilize; means for analyzing said benefit-provider

information and said benefit correlation information to determine whether any benefit-providers are offering potentially applicable benefits for said data and whether said data satisfies requirements for obtaining said potentially applicable benefits; means for displaying a message to inform a system user of any available benefits applicable to said data; wherein said benefits includes at least one of a discounted rate or value available to the entity as a result of entity's qualifying or being eligible for at least one benefit available from at least one benefit provider ([www.collegeboard.com](http://www.collegeboard.com)).

17. As per Claims 16 and 101, College Board discloses means for displaying a plurality of available benefits applicable to said data, said plurality of benefits listed in a manner selected from the group consisting of benefit class or category, *value of benefits*, cost (if any) of benefits, importance of benefits, relevance of benefits, ease of use of benefits, *expiration (date) of benefits*, creation (date) of benefits, type of benefits, and physical proximity of said entity to one or more said benefit providers ([www.collegeboard.com](http://www.collegeboard.com)).
18. As per Claims 17 and 102, College Board discloses means for said entity to self-select said manner of benefits listing display ([www.collegeboard.com](http://www.collegeboard.com)).
19. As per Claims 18, 19, 103, and 104, College Board discloses means for the storage within said system of (some portion of) said entity's benefit-search results for entity's future viewing and use ([www.collegeboard.com](http://www.collegeboard.com)).
20. As per Claims 20, 21, 105, and 106, College Board discloses means for the storage outside said system of (some portion of) said entity's benefit-search results for entity's future viewing and use ([www.collegeboard.com](http://www.collegeboard.com)).

Art Unit: 3629

21. As per Claims 25 and 110, College Board discloses wherein said system is a computer system ([www.collegeboard.com](http://www.collegeboard.com)).
22. As per Claims 26 and 111, College Board discloses wherein said means for displaying a message that further does not specify at least one benefit provider ([www.collegeboard.com](http://www.collegeboard.com)).
23. As per Claims 27 and 112, College Board discloses wherein said means for displaying a message that further does not specify at least one benefit ([www.collegeboard.com](http://www.collegeboard.com)).
24. As per Claims 46 and 131, College Board discloses means for receiving directly or via third party intermediaries of monetary revenue or other value from at least one from the benefit provider group of: governments; and education institutions; and commercial enterprises; and individuals; and non-profits and charities ([www.collegeboard.com](http://www.collegeboard.com)).
25. As per Claims 47 and 132, College Board discloses means for updating benefits data; and modifying benefits data; and removing benefits data; and adding new benefits data ([www.collegeboard.com](http://www.collegeboard.com)).
26. As per Claim 48, College Board discloses means for updating entity data; and modifying entity data; and removing entity data; and adding new entity data ([www.collegeboard.com](http://www.collegeboard.com)).
27. As per Claims 49 and 133, College Board discloses means for: providing the physical address of the benefit providers; and providing benefit providers' contact information; and providing a map for and direction to the benefit providers ([www.collegeboard.com](http://www.collegeboard.com)).
28. As per Claims 50 and 134, College Board discloses wherein the name, address, phone number and other contact information of one or more of said benefit providers is not revealed to said entity ([www.collegeboard.com](http://www.collegeboard.com)).

29. As per Claims 54 and 138, College Board discloses without leaving system, means for connecting said entity with at least one of said plurality of benefit providers directly via said system; and means for said entity to interact with said benefit providers via said system; and means for said benefit providers to offer said benefits to said entity via said system; and means for completion of said application forms, when applicable, by said entity via said system; and means for transmitting said benefit approval for said entity by said benefit providers via said system; and means for transmitting an acceptance of said benefits by said entity via said system; and means for receiving said benefits by said entity via system; and means for using said benefits by said entity via system ([www.collegeboard.com](http://www.collegeboard.com)).
30. As per Claims 55 and 139, College Board discloses means for performing said direct via system process in real time ([www.collegeboard.com](http://www.collegeboard.com)).
31. As per Claims 58 and 142, College Board discloses wherein said entity benefits information is shared with at least one other entity via: said system; and an internet ([www.collegeboard.com](http://www.collegeboard.com)).
32. As per Claims 59 and 143, College Board discloses wherein said entity benefits is shared with at least one other entity via: said system; and an internet ([www.collegeboard.com](http://www.collegeboard.com)).
33. As per Claims 60 and 144, College Board discloses wherein said benefits have no acquisition or utilization qualifications; nor eligibility requirements ([www.collegeboard.com](http://www.collegeboard.com)).
34. As per Claims 61 and 145, College Board discloses means for obtaining, displaying, accepting, providing and/or utilization of at least one of said benefits ([www.collegeboard.com](http://www.collegeboard.com)).



35. As per Claims 62 and 146, College Board discloses means for displaying benefits for which said entity: may qualify for one or more benefits; and may not qualify for one or more benefits; and does qualify for one or more benefits; and does not qualify for one or more benefits ([www.collegeboard.com](http://www.collegeboard.com)).
36. As per Claims 64 and 148, College Board discloses wherein said entity may at entity's option have said message display inform entity of at least one benefit contained within said memory without regards to: said set of entity data; and whether or not entity qualifies for or is eligible for any such said benefits ([www.collegeboard.com](http://www.collegeboard.com)).
37. As per Claims 65 and 149, College Board discloses wherein one or more of said benefit providers may at benefit provider's option submit said benefit information directly into said system ([www.collegeboard.com](http://www.collegeboard.com)).
38. As per Claims 66 and 150, College Board discloses wherein said benefit information is delivered directly into said system via at least one third party intermediary acting on behalf of at least one of said benefit providers ([www.collegeboard.com](http://www.collegeboard.com)).
39. As per Claims 67 and 151, College Board discloses wherein said entity selects frequency of said system updates regarding said entity's benefit information concerning; at least one benefit; and at least one class of benefits ([www.collegeboard.com](http://www.collegeboard.com)).
40. As per Claims 68 and 152, College Board discloses wherein the number of said displayed applicable benefits varies according to: amount of said entity data; and the data fields said entity fills in; and the completeness of said entity data ([www.collegeboard.com](http://www.collegeboard.com)).
41. As per Claims 69, 70, 153, and 154, College Board discloses wherein said entity may at entity's option input a complete set (partial set) of "phantom" data; wherein said "phantom"

Art Unit: 3629

data does not belong to nor correspond to said entity's actual factual data

(www.collegeboard.com).

42. As per Claims 71 and 155, College Board discloses wherein said system is operated via an internet (www.collegeboard.com).

43. As per Claims 72 and 156, College Board discloses wherein said benefit information is delivered via an internet (www.collegeboard.com).

44. As per Claims 73 and 157, College Board discloses where in one or more benefits are delivered via an internet (www.collegeboard.com).

45. As per Claims 74 and 158, College Board discloses wherein one or more benefits are utilized via an internet (www.collegeboard.com).

46. As per Claims 77 and 161, College Board discloses wherein there is no entity data set (www.collegeboard.com).

47. As per Claims 78 and 162, College Board discloses wherein there are no qualification or eligibility parameters (www.collegeboard.com).

48. As per Claims 79 and 163, College Board discloses wherein said benefit message display excludes at least one benefit provider offering at least one benefit (www.collegeboard.com).

49. As per independent Claims 80 and 82, College Board discloses a system comprising a memory device having embodied therein information relating to a plurality of benefits; a processor in communication with said memory device, said processor configured to: create a benefits listing for a specifies entity with a specifies set of demographic, geographic, psychographic, and preference data; make available said benefits listing; examine a plurality of benefits that are available to a plurality of entities, said listing to determine which of said

plurality of benefits having qualification parameters; select at least one of said plurality benefits; and provide notification of benefit information to said entity, including the benefit providers corresponding to said selected benefits ([www.collegeboard.com](http://www.collegeboard.com)).

50. As per independent Claim 81, College Board discloses a system comprising: a memory device having embodied therein information relating to a plurality of benefits; a processor in communication with said memory device, said processor configured to: receive a benefits listing for a specified entity with a specified set of demographic, geographic, psychographic, and preference data; provide said benefits listing to an entity; receive an acceptance of said benefits listing from said entity; transmit said acceptance to a benefit information provider; and receive benefit information selected by said benefit information provider, including the benefit providers corresponding to said selected benefits ([www.collegeboard.com](http://www.collegeboard.com)).
51. As per Claim 83, College Board discloses means for inputting into said system said entity data, which also includes entity identification information ([www.collegeboard.com](http://www.collegeboard.com)).
52. As per Claim 84, College Board discloses means for comparing said entity data, which also includes entity identification information ([www.collegeboard.com](http://www.collegeboard.com)).
53. As per Claim 85, College Board discloses means for analyzing said entity data, which also includes entity identification information ([www.collegeboard.com](http://www.collegeboard.com)).
54. As per Claim 86, College Board discloses means for said displaying of a message wherein said entity data also contains entity identification information ([www.collegeboard.com](http://www.collegeboard.com)).
55. As per independent Claims 164 and 169, College Board discloses a method of using a computer to process a benefit information request, comprising the steps of: creating a benefit listing; outputting said benefit listing via electronic system; examining a plurality of benefits

which would fulfill the benefit information request relating to said benefit listing to determine which if any, of said plurality of benefits to select for said benefit listing; selecting, when available, at least one of said plurality of benefits; outputting notification of benefit information corresponding to said selected benefits and accepting at least one of said benefits ([www.collegeboard.com](http://www.collegeboard.com)).

56. As per Claims 166 and 171, College Board discloses wherein said receiving (creating) benefit information includes receiving (creating) benefit information that further does not specify one or more benefit providers ([www.collegeboard.com](http://www.collegeboard.com)).
57. As per Claims 167 and 173, College Board discloses transmitting (receiving) a request of said benefit information; and receiving (transmitting) an acceptance of said benefit information ([www.collegeboard.com](http://www.collegeboard.com)).
58. As per Claims 168 and 172, College Board discloses wherein said receiving a request (outputting notification) includes receiving a request that further contains at least partially inaccurate, "phantom" information concerning benefit seeker ([www.collegeboard.com](http://www.collegeboard.com)).
59. As per Claim 174, College Board discloses providing a benefit listing without one or more of benefit providers being listed ([www.collegeboard.com](http://www.collegeboard.com)).
60. As per Claim 175, College Board discloses wherein said step of outputting notification includes the step of providing a benefit information listing with benefit providers being listed ([www.collegeboard.com](http://www.collegeboard.com)).
61. As per independent Claim 176, College Board discloses a method comprising the steps of: viewing, using a computer benefit information; transmitting, using a computer, a request to obtain at least one benefit corresponding to said benefit information; receiving a commitment

Art Unit: 3629

for at least one benefit; accepting said commitment for said at least one benefit; and receiving said at least one benefit (www.collegeboard.com).

62. As per Claim 177, College Board discloses inputting into said system said entity data, which also includes entity identification information (www.collegeboard.com).

63. As per Claim 178, College Board discloses comparing said entity data, which also includes entity identification information (www.collegeboard.com).

64. As per Claim 179, College Board discloses analyzing said entity data which data also includes entity identification information (www.collegeboard.com).

65. As per Claim 180, College Board discloses displaying said message wherein said entity data also contains entity identification information (www.collegeboard.com).

***Claim Rejections - 35 USC § 103***

66. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

67. Claims 22-24, 29, 30, 51-53, 107-109, 114, 115, and 135-137 are rejected under 35

U.S.C. 103(a) as being obvious over College Board.

68. As per Claims 22-24, and 107-109, College Board fails to expressly disclose means for the notification of said entity upon the (impending) modification to, update of change to, elimination of, the creation of one or more benefits offered by one or more benefit providers,

or that one or more benefits said entity previously did not qualify to receive but for which said entity now does qualify to receive.

69. However College Board does teach about the EXPAN system which maintains a profile on users ([www.collegeboard.com](http://www.collegeboard.com)), and automated e-mail systems were well known at the time the invention was made.
70. Therefore, it would have been obvious to include means for the notification of said entity upon the (impending) modification to, update of change to, elimination of, the creation of one or more benefits offered by one or more benefit providers, or that one or more benefits said entity previously did not qualify to receive but for which said entity now does qualify to receive to the system disclosed by College Board, for the advantage of offering users current information, and keeping users connected to the system – in order to maintain a large system user-base (increase advertising).
71. As per Claims 29 and 114, College Board fails to expressly disclose means of requiring said entity to update said entity data as a condition of said entity continuing to remain a system user.
72. However, College Board does teach the use of the EXPAN system, which maintains a profile on users of the system ([www.collegeboard.com](http://www.collegeboard.com)), and therefore, it would have been obvious and well known at the time the invention was made, to require users to periodically update their profiles for the advantage of reducing bounce-backs of information transmittal (due to incorrect profile information), and maintaining an up-to-date profile database.
73. As per Claims 30, 53, 115, and 137, College Board fails to expressly disclose means for said entity to pay for said system access, use, and/or application assistance.

74. However, College Board is an advertisement-based system instead of a fee-based system, and web-commerce (internet payment systems) was well known at the time the invention was made.
75. Therefore, it would have been obvious to include means for said entity to pay for said system access, use, and/or application assistance with the College Board system, for the advantage of offering a fee-based system to users, and an additional source of income.
76. As per Claims 51, 52, 135, and 136, College Board fails to expressly disclose wherein said means for displaying said benefits include means for displaying any benefit provider required benefit application forms and means for assisting said entity in the completion of said application forms.
77. However, College board does offer links to college entrance application forms and also offers help in completing said forms through the EXPAN system ([www.collegeboard.com](http://www.collegeboard.com)).
78. Therefore it would have been obvious to include means for displaying any benefit provider required benefit application forms and means for assisting said entity in the completion of said application forms with the system disclosed by College Board, for the advantage of offering additional serves and help to the system's users.
79. Claims 2-15, 28, 31-45, 56, 57, 63, 88-100, 113, 116-130, 140, 141, 147, 165, and 170 are rejected under 35 U.S.C. 103 as being unpatentable over College Board.
80. As per Claims 2-8 and 88-94, College Board does not expressly show providing additional benefit correlation information concerning individual benefit seekers, groups of two or more

benefit seekers, business benefit seekers, non-profit and charity benefit seekers, governmental benefit seekers, or educational institution benefit seekers.

81. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The benefit matching system/method would be performed regardless of whom the benefit correlation concerned. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
82. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have correlated benefit information concerning individual benefit seekers, groups of two or more benefit seekers, business benefit seekers, non-profit and charity benefit seekers, governmental benefit seekers, or educational institution benefit seekers, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
83. As per Claims 9-15 and 95-100, College Board discloses displaying a plurality of available benefits applicable to said data ([www.collegeboard.com](http://www.collegeboard.com)); however, College Board does not expressly show, said plurality of benefits listed for an individual, groups of two or more individuals, a business, non-profit or charity, government, a family, or an educational institution.
84. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The benefit matching system/method would be



performed regardless of how the benefits were listed. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

85. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have listed the benefits listed for an individual, groups of two or more individuals, a business, non-profit or charity, government, a family, or an educational institution, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

86. As per Claims 28 and 113, College Board discloses obtaining benefit information ([www.collegeboard.com](http://www.collegeboard.com)); however, College Board does not expressly show obtaining benefit information from: governmental benefit providers; and non-governmental benefit providers; and non-profit and charity benefit providers; and corporate and business benefit providers; and education institution benefit providers; and private individual benefit providers.

87. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The benefit matching system/method would be performed regardless of where the benefit information was obtained. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

88. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have obtained benefit information from governmental benefit providers; and non-governmental benefit providers; and non-profit and charity benefit providers; and corporate and business benefit providers; and education institution benefit providers; and private individual benefit providers, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
89. As per Claims 31-45 and 116-130, College Board does not expressly show wherein said entity to pays for system access and use on a per time interval basis, per month or fraction thereof basis; per week or fraction thereof basis; per year or fraction thereof basis; per day or fraction thereof basis; per minute or fraction thereof basis; per second or fraction thereof basis, per use of said system basis, per benefit disclosed basis, per benefit received basis, per benefit utilized basis, subscription basis, pre-paid basis, post-paid basis, credit card or debit card guaranteed basis, through said entity's relinquishment of a least a portion of at least one of said benefits, through the payment of some percentage of at least one of the said benefits, through the payment from a plurality of at least part of a value equivalent of at least one of said benefits, having any incurred costs or fees charged to said entity's phone bill, or pays nothing for system access and use.
90. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The benefit matching system/method would be performed regardless of how the entity paid for the system access and use. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of

patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

91. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the entity pay for the system access and use on a per time interval basis, per month or fraction thereof basis; per week or fraction thereof basis; per year or fraction thereof basis; per day or fraction thereof basis; per minute or fraction thereof basis; per second or fraction thereof basis, per use of said system basis, per benefit disclosed basis, per benefit received basis, per benefit utilized basis, subscription basis, pre-paid basis, post-paid basis, credit card or debit card guaranteed basis, through said entity's relinquishment of at least a portion of at least one of said benefits, through the payment of some percentage of at least one of the said benefits, through the payment from a plurality of at least part of a value equivalent of at least one of said benefits, having any incurred costs or fees charged to said entity's phone bill, or pays nothing for system access and use, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
92. As per Claims 56, 57, 63, 140, 141, and 147, College Board discloses displaying and delivering said message ([www.collegeboard.com](http://www.collegeboard.com)); however, College Board does not expressly show displaying and delivering said message in visual form; printed form, audible form, graphical form, electronic storage form, data form, FAX form, brail form, e-mail form, in a plurality of languages, or on a constantly rotating or "scrolling" basis.
93. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The benefit matching system/method would be

performed regardless of how the message was displayed and delivered. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

94. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have displayed and delivered the benefit message in visual form; printed form, audible form, graphical form, electronic storage form, data form, FAX form, brail form, e-mail form, in a plurality of languages, or on a constantly rotating or “scrolling” basis, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

95. As per Claims 165 and 170, College Board does not expressly show wherein said receiving (notification and accepting) a request includes receiving (outputting and accepting) a request for benefit information from the group consisting of an individual, a group of two or more benefit seekers, a business, a non-profit, a charity, a government, a family, and an educational institution.

96. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The benefit matching system/method would be performed regardless of whom the request was received, transmitted, or accepted. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

97. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have received, transmitted, or accepted a request from an individual, a group of two or more benefit seekers, a business, a non-profit, a charity, a government, a family, and an educational institution, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

### *Conclusion*

98. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

99. The following US patent is cited to show the best patented domestic prior art found by the examiner:

#### **U.S. Pat. No. 6,266,648 to Baker, III**

Baker discloses a computer system that can correlate benefits between consumers and one or more enabling organizations – permitting consumers to more effectively make use of a variety of available benefits from a plurality of goods and services providers.

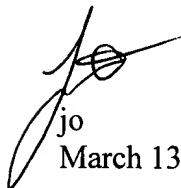
100. The following foreign patent is cited to show the best foreign prior art found by the examiner:

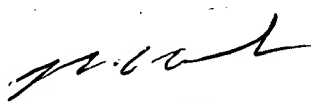
#### **PCT No. WO 200129708 A1 to Koenig**

Art Unit: 3629

Koenig discloses an internet-based service matching method, which involves establishing a match between two parties using the matching database and informing the corresponding parties.

101. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
102. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.
103. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

  
jo  
March 13, 2003

  
**JOHN G. WEISS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**